

Claims rejected under 35 U.S.C. § 103(a):

The office action rejected claims 1-51 under 35 U.S.C. § 103(a) as unpatentable over Norris et al. in view of Birckbichler. Applicant respectfully traverses the rejections and submits the following arguments in support of his position.

The office action correctly notes that neither cited reference teaches all of the limitations of any of the claims, including, for example, independent claim 1. For instance, as noted in the office action, Norris et al. fails to teach (or even to suggest) prompting a caller for identification, receiving an audible identification from the caller, or providing the audible identification to the subscriber. The office action asserts, however, that these limitations are taught by Birckbichler. Even assuming, *arguendo*, that this assertion were true, the office action can point to no teaching, motivation or suggestion in either reference, or in the art, to combine the teachings of these two references.

Applicants submit, therefore, that the combination of these two references cannot support a *prima facie* case of obviousness with respect to, for instance claim 1. The disclosure of Birckbichler is similar to that of Serbetcioglu (U.S. Patent No. 5,511,111), which the Examiner considered in the first office action (Paper No. 2), in that both references teach systems for receiving a verbal identification from a caller and relaying that verbal identification to a subscriber. Like Serbetcioglu, however, Birckbichler fails to provide any teaching, suggestion or motivation that its disclosure could be combined with a computer system, such as that provided by Norris et al. Conversely, the teaching of Norris et al. is similar to that of McMullin (U.S. Patent No. 5,809,128), also considered in the first office action (Paper No. 2), in that both references teach providing caller identification via a computer network, but neither reference contains any teaching, motivation or suggestion to combine that feature with a spoken caller identification, such as that taught by Birckbichler or Serbetcioglu.

Moreover, as noted in the response to the first office action (Paper No. 3), these known teachings of each reference are discussed in the background of the present application. For instance, the background discusses the inventive concept of Birckbichler (and Serbetcioglu), noting that "some telephone subscribers also subscribe to a feature in which incoming calls . . .

are 'screened.' For screening, the telephone system first prompts the calling party to audibly identify itself to the telephone system. This audible identification is then played to the subscriber, who can then decide to accept or reject the call" (p.1, lns. 13-18). The background also discusses the teaching of Norris et al. (and McMullin), noting that "[c]aller ID can also be provided to a telephone subscriber logged onto the Internet via the subscriber's line" (p.1, lns. 19-20).

As noted in the background, however, and as demonstrated by Norris et al., prior to the invention claimed in this application, the art failed to contemplate sending any caller identification information other than text to the subscriber via the computer network. For example, Norris et al. discloses that "terminal DT1 displays the information characterized by the data . . . on the terminal DT1 display, thereby alerting the subscriber to the waiting call," (col. 6, lns. 45-48), clearly teaching the use of a "pop-up" window or other visual device to alert the subscriber. As the background of the present application notes, however, "[e]ven if a subscriber subscribes to both the caller ID and audible identification feature, the pop-up screen for a call with no calling party information would simply show that the calling party identification is not available. The audible identification cannot be provided to the subscriber." (p. 2, lns. 7-10) (emphasis added). Thus, as clearly discussed in the background of the application, the prior art contains no teaching, motivation or suggestion to combine the known "audible identification" feature with the known "computer caller identification" feature.

Hence, like the earlier-considered references, neither Norris et al. nor Birckbichler provide any teaching, suggestion or motivation to combine these features, and the current office action continues to fail to identify any such suggestion or motivation elsewhere in the art. It is only in retrospect, in light of the disclosure of this application, that the office action can assert that providing audible caller information via a computer network is obvious. The use of such hindsight in an obviousness rejection is improper. See MPEP § 2142 ("The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."). Here, neither


the first office action (Paper No. 2) nor the current office action identifies any teaching, suggestion or motivation in the art to combine the cited references, and the cited references fail to support any *prima facie* case of obviousness. Claim 1 therefore is allowable over the cited references, either alone or in combination. For similar reasons, independent claims 8, 13, 19, 24, 33 and 44 are allowable. Dependent claims 2-7, 9-12, 14-23, 25-32, 34-43 and 45- 51 are allowable as depending from allowable base claims as well as being directed to specific novel substitutes. Applicant respectfully requests, therefore, that the rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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